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09/680,697	10/06/2000	Walter W. Collins	530055.413R1	1037

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SEED INTELLECTUAL PROPERTY LAW GROUP PLLC  
701 FIFTH AVE  
SUITE 5400  
SEATTLE, WA 98104

EXAMINER

DEXTER, CLARK F

ART UNIT	PAPER NUMBER
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3724

MAIL DATE	DELIVERY MODE
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03/13/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/680,697	<b>Applicant(s)</b> COLLINS, WALTER W.	
	<b>Examiner</b> Clark F. Dexter	<b>Art Unit</b> 3724	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-25, 27-29, 34-37, 45, 52, 54, 58-60 and 62-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13 and 15-22 is/are allowed.
- 6) ☒ Claim(s) 23-25, 27-29, 34-37, 45, 52, 54, 58-60 and 62-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____                                                         | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The amendment filed on July 18, 2007 and December 19, 2007 have been made of record.

#### ***Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 23-25, 27-29, 58-60, 62, 63, 65 and 66 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 58-60, 62, 63 and 66, the disclosure still does not appear to provide support for the subject matter set forth in the subject claims. While the applicant has taken the position held by the Examiner in the previous Office action that the claimed "biasing element" refers to the spring, and that the spring can clearly be considered to be a biasing element, the claim remains deficient as follows.

The disclosure does not provide support for the ends of the biasing element (now interpreted by applicant to be the spring 90) being coupled to the handle and blade respectively. That is, there is no single integral feature or plural integral features that

Art Unit: 3724

couple(s) the end of the spring to the handle, or the end of the spring to the blade.

Rather, both ends of the spring 90 are free and are not coupled to anything. Further, the element that is coupled to the handle is pin 95 or the integral combination of pin 95 and sleeve or collar 92, wherein the sleeve or collar 92 is coupled to shaft 80, not to spring 90; similarly, the element that is coupled to the blade is pin 86 or the integral combination of pin 86 and yoke or clevis 82, wherein the yoke or clevis 82 is coupled to shaft 80, not to spring 90. Thus, it is respectfully submitted that there remains no support for the claimed subject matter.

Further, regarding claims 23-25, 27-29 and 65, the original disclosure does not provide support for the combination now set forth in claims 23 and 65 of:

“said blade having an aperture, and

a blade pivot connected to said first end of said handle and extending through the aperture for pivotal movement of said blade about said blade pivot between an extended position wherein the blade is outside of said blade cavity and a retracted position wherein the majority of the blade is substantially within said blade cavity.”

Rather support is provided for the blade having a pivot pin 56 that is connected to the first end of the handle for pivotal movement of said blade about said blade pivot between an extended position and a retracted position.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

4. Claims 58-60, 62, 63 and 66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 58, 62, and 66, line 6 of each claim, the recitation "a contact pin" is vague and indefinite as to what disclosed structure is being referred, particularly as to what disclosed "pin" is being referred (it is noted that the only disclosed "pin" that appears to be coupled to the blade is either pin 20 or pin 56, neither of which is capable of performing the claimed function; and the disclosed structure that is capable of performing the claimed function is the plurality of ridges such as recited in claim 60).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 45 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown, pn 1,864,011.

**Regarding claim 45**, Brown '011 discloses a folding knife with every structural limitation of the claimed invention including:

a handle (e.g., structure including 9, 10);

a blade (e.g., 1, 1) pivotally coupled to the handle to be moveable about a blade pivot point (e.g., 11, 11), such that the blade moves between a stowed position (e.g., shown in Fig. 1) and a deployed position;

a plunger (e.g., the left portion of 3, or the right portion of 3 as viewed in Fig. 1) coupled between the handle and the blade such that a portion of the plunger remains a fixed distance from the blade pivot point (e.g., the left portion of 3 remains a fixed distance from the right pivot point 11, particularly during pivoting of the upper blade 1 about the right pivot point; and the right portion of 3 remains a fixed distance from the left pivot point 11, particularly during pivoting of the lower blade 1 about the left pivot point); and

a spring (e.g., 8) coupled to the plunger to act on the blade to urge the blade into the stowed position when the blade is moved to the stowed position, and operates on the blade to urge the blade toward the deployed position when the blade is moved by an outside force from the stowed position at least partially toward the deployed position.

**Regarding claim 52**, Brown '011 discloses a folding knife with every structural limitation of the claimed invention including:

a handle (e.g., structure including 9, 10);

a blade (e.g., 1, 1) having a tang coupled to the handle, the blade configured to rotate, relative to the handle, between a retracted position (e.g., shown in Fig. 1) and an extended position; biasing means (e.g., 8) for holding the blade in the retracted position in the handle while the blade is in the retracted position and for biasing the blade toward

Art Unit: 3724

the extended position relative to the handle when the blade is moved from the retracted position past a point of maximum bias toward the extended position; and

moving means (e.g., the notch located on the blade between numerals 1 and 7, wherein the notch can clearly be accessed by a finger of a user's hand and pushed toward an open/extended position while the user is holding the knife in the same hand) for moving the blade from the retracted position to the extended position with one hand while holding the knife with the same one hand.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 58, 59, 62 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, pn 1,864,011 (Brown '011) in view of Yablonovitch, pn 5,009,008 or Ennis, pn 5,095,624.

**Regarding claims 58 and 59**, Brown '011 discloses a folding knife with almost every structural limitation of the claimed invention including:

a handle (e.g., structure including 9, 10);

a blade (e.g., 1, 1) having a tang end coupled to the handle, the blade configured to rotate, relative to the handle, through an arc between a retracted position (e.g.,

Art Unit: 3724

shown in Fig. 1) and an extended position when an opening force is applied to the blade;

- a biasing element including a spring (e.g., 8);

- a first coupling element (e.g., the leftmost portion of 3) operatively coupling a first end of the biasing element to the handle; and

- a second coupling element (e.g., the rightmost portion of 3) operatively coupling a second end of the biasing element to the blade;

[claim 59] wherein the biasing element is arranged such that the spring thereof increases in tension to a point of maximum tension as the blade is moved through the arc from the retracted position toward the extended position, then decreases in tension as the blade continues past the point of maximum tension toward the extended position.

**Regarding claim 62**, Brown '011 discloses a folding knife with almost every structural limitation of the claimed invention including:

- a handle (e.g., structure including 9, 10);

- a blade (e.g., 1, 1) having a tang end coupled to the handle, the blade configured to rotate, relative to the handle, through an arc between a retracted position (e.g., shown in Fig. 1) and an extended position when an opening force is applied to the blade;

- a biasing element including a spring (e.g., 8), configured to apply a closing force to the blade while the blade is in the retracted position;

- a first coupling element (e.g., the leftmost portion of 3) operatively coupling a first end of the biasing element to the handle; and



Art Unit: 3724

a second coupling element (e.g., the rightmost portion of 3) operatively coupling a second end of the biasing element to the blade.

**Regarding claim 63**, Brown '011 discloses a folding knife with almost every structural limitation of the claimed invention including:

a handle (e.g., structure including 9, 10);

a blade (e.g., 1, 1) having a tang end coupled to the handle, the blade configured to rotate, relative to the handle, through an arc between a retracted position (e.g., shown in Fig. 1) and an extended position when an opening force is applied to the blade;

a biasing element including a spring (e.g., 8), configured to resist rotation of the blade toward the extended position while the blade is in the retracted position;

a first coupling element (e.g., the leftmost portion of 3) operatively coupling a first end of the biasing element to the handle; and

a second coupling element (e.g., the rightmost portion of 3) operatively coupling a second end of the biasing element to the blade.

**Brown lacks:**

a contact element on the blade, positioned such that a user, holding the knife in one hand, can apply an opening force to the blade with a finger of the same hand.

However, such contact pins are old and well known in the art and facilitate removing the blade from the handle. Yablonovitch and Ennis each discloses one example of such a contact pin. Therefore, it would have been obvious to one having ordinary skill in the art to provide such a contact pin on the knife of Brown to gain the

Art Unit: 3724

well known benefits such as that described above as well as those described in Yablonovitch and Ennis.

9. Claims 54 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, pn 1,864,011 (Brown '011) as described above for claims 52 and 58, and further in view of Thompson et al., pn 5,131,149 (Thompson '149).

Brown '011 lacks the first end of the blade having an extension with a plurality of ridges thereon or, for claims 54 and 60, a plurality of directional saw-like teeth, or a pin coupled to an upper portion of the blade. Thompson '149 discloses a blade having such a plurality of ridges on a first end of the blade and teaches that it facilitates one-handed actuation of the blade. Therefore, it would have been obvious to one having ordinary skill in the art to provide an extension having a plurality of ridges on the blade of Brown '011 for the benefits taught by Thompson '149 including that described above.

10. Claims 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, pn 1,864,011 (Brown '011).

Brown discloses a folding knife with almost every structural limitation of the claimed invention including a blade (e.g., 1), and an elongate, force-transmitting spring (e.g., 8) that performs the recited function(s), and a plunger (e.g., the portion to which the lead line for numeral 3 contacts). Further, the spring of Brown is operatively attached between the blade and the handle; for example, the spring (e.g., 8) is operatively attached to the handle via the leftmost portion corresponding to 3 and the associated pins (e.g., 11, 12) and openings (e.g., 5, 6), and the spring is also

Art Unit: 3724

operatively connected to the blade via the rightmost portion corresponding to 3 and the associated pins (e.g., 11, 13) and openings (e.g., 5, 14).

Brown lacks the spring operating in the claimed direction; that is, a spring that exhibits the decrease in effective length as the blade is moved from one of the stowed and deployed conditions toward an intermediate point, and an increase in effective length as the blade is moved from the intermediate point toward the other conditions. However, it is old and well known in the art that springs operating in tension are equivalent to springs operating in compression, particularly since such springs are well known equivalents. Therefore, it would have been obvious to one having ordinary skill in the art to simply change the type of the spring that operates in tension to a spring that operates in compression.

11. Claim 66 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Brown, pn 1,864,011 (Brown '011) in view of Yablonovitch, pn 5,009,008 or Ennis, pn 5,095,624 as described above for claim 63 and, if necessary, further in view of Cassady, pn 5,293,690 (hereafter Cassady '690) or Howard, pn 4,985,998.

It is noted that claim 66 is a combination of claim 63 with the addition of a locking member as claimed at the end of claim 66, and the prior art combination applied to claim 63 teaches a knife with almost every structural limitation of the claimed invention as described above for claim 63 but lacks a locking member as claimed. However, the Examiner takes Official notice that such locking members are old and well known in the art and provide various well known benefits including facilitating cutting and manipulating the knife during cutting while avoiding inadvertent closing of the knife

Art Unit: 3724

interrupting the cutting operation and/or causing injury to the user. It is noted that there are two subclasses (160, 161) in class 30 directed specifically toward such locking mechanisms. Cassady '690, Ennis and Howard each discloses an example of one of the various types of such locking mechanisms. Therefore, it would have been obvious to one having ordinary skill in the art to provide such a locking member on the knife of Brown '011 for the well known benefits including those described above.

### ***Issues Relating to Reissue Application***

12. Claims 23-25, 27-29, 34, 36, 37, 45, 52, 54, 58-60 and 62-66 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Each of reissue claims 23, 34, 45, 52, 58 and 62-66 is an independent claim that fails the Third Step of the test set forth by the Court of Appeals for the Federal Circuit (see MPEP 1412.02). Specifically, at least one of the limitations added during the prosecution of the patent to distinguish over the prior art (that is, at least one of the surrender-generating limitations) was:

“the first end of the plunger being slidably carried by said pivotal connector as said blade moves between said retracted and extended positions.”

It is noted that while reissue claim 12, which is NOT rejected as being an improper recapture, is broader than patent claim 1 in the area of surrender, it does not entirely omit the limitation but rather sets forth that the first end of the plunger *assembly* is slidably and pivotally connected to the *handle*, rather than being slidably connected to a pivotal connector that is connected the handle. Thus, claim 12 merely recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection. It is noted that reissue claim 12 is considered narrower than patent claim 1 in other respects; specifically, the subject matter in the third paragraph of the claim which recites that the plunger assembly is configured to maintain the blade in the extended position ... , and to retain the blade in the retracted position ... . Therefore, claim 12 is NOT considered to be a claim that impermissibly recaptures what was previously surrendered and therefore is NOT barred under 35 U.S.C. 251.

However, none of reissue claims 23, 34, 45, 52, 58 and 62-66 include a recitation relating to the surrender-generating limitation recited above. Thus, these claims

Art Unit: 3724

impermissibly recapture what was previously surrendered, and are barred under 35 U.S.C. 251.

***Allowable Subject Matter***

13. Claims 1-13 and 15-22 are allowable over the prior art of record.

***Claimed Subject Matter***

14. Claims 23-25, 27-29, 65 and 66 are considered to read over the prior art of record because the prior art or record does not teach or suggest the claimed combination of features including a blade as claimed, a blade pivot as claimed, and a plunger pivotally connected to the blade at a first end and pivotally connected to the handle at a second end. However, these claims **cannot** be considered to be “allowable” at this time due to the rejection(s) under 35 U.S.C. 112, 1<sup>st</sup> paragraph set forth in this Office action. Therefore, upon the claims being rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action, further consideration of these claims with respect to the prior art will be necessary.

Additionally, claims 23-25, 27-29, 37, 65 and 66 **cannot** be considered to be “allowable” at this time due to the rejection(s) under 35 U.S.C. 251 (improper recapture) set forth in this Office action. Therefore, upon the claims being rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action, further consideration of these claims with respect to the prior art will be necessary.

***Response to Arguments***

15. Applicant's arguments filed December 19, 2007 have been fully considered but they are not persuasive.

Regarding applicant's argument directed to claim 45 in the second paragraph on page 12 of the subject response, the Examiner respectfully disagrees. Applicant argues that:

"In Brown, the plate 3 moves back and forth and no portion remains in the fixed position."

It is respectfully submitted that this statement is inaccurate. Clearly, when only one blade is opened (e.g., the blade with the rightmost pivot), the opposite end of plate 3 corresponding to the other blade (e.g., the blade with the leftmost pivot) does not move. Therefore, at least the portion of the plate 3 (e.g., the left portion of plate 3) remains a fixed distance from the blade pivot point (e.g., the rightmost blade pivot).

Regarding applicant's arguments directed to claim 52 in the third paragraph on page 12 of the subject response, the Examiner respectfully disagrees with applicant's position and maintains that the subject component(s) of Brown '011 are equivalent with respect to those disclosed in the present application in that they perform substantially the same function in substantially the same manner to produce substantially the same results.

Regarding applicant's arguments directed to claims 58, 62 and 63 on pages 12-14 of the subject response, the Examiner respectfully maintains that, although these claims have been rejected under 35 USC 112, 1<sup>st</sup> paragraph as not having support in

Art Unit: 3724

the original disclosure, they are also taught or fairly suggested by the prior art and further described in the prior art rejections above.

For at least the above reasons, it is respectfully submitted that the rejections must be maintained.

### ***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.



Art Unit: 3724

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Clark F. Dexter/  
Primary Examiner, Art Unit 3724

cfd  
March 4, 2008